


Modified PTO/SB/33 (10-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number	
		Q81022	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number	Filed	
	10/826,301	April 19, 2004	
	First Named Inventor		
	Masahiko HIROSE		
	Art Unit	Examiner	
	1723	Krishnan S. MENON	
WASHINGTON DC SUGHRUE/265550			
65565			
CUSTOMER NUMBER			
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal			
The review is requested for the reasons(s) stated on the attached sheet(s).			
Note: No more than five (5) pages may be provided.			
<input checked="" type="checkbox"/> I am an attorney or agent of record.			
Registration number		47,121	
		 Signature	
		Keiko K. Takagi Typed or printed name	
		(202) 293-7060 Telephone number	
		May 21, 2007 Date	

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: Q81022

Masahiko HIROSE, et al.

Appln. No.: 10/826,301

Group Art Unit: 1723

Confirmation No.: 9820

Examiner: Krishnan S. MENON

Filed: April 19, 2004

For: COMPOSITE SEMIPERMEABLE MEMBRANE AND PROCESS FOR PRODUCING THE SAME

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**MAIL STOP AF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated January 25, 2007, Applicants file this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicants turn now to the rejections at issue:

Initially, the Advisory Action indicates that the Amendment filed April 25, 2007 overcame the obviousness-type double patenting rejection. Thus, the remaining rejections are (1) the rejection of claims 1-5 and 7-6 under 35 U.S.C. § 102(b) as allegedly being anticipated by WO 99/01208 ("Hirose"), and (2) the rejection of claims 1-16 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. patent 6,464,873 ("Tomaschke").

Applicants respectfully traverse the rejections and respectfully submitted that Hirose and Tomaschke do not anticipate claims 1-16.

Regarding Hirose, the Examiner takes the position that polyacrylic acid is an organic

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acid, and since Hirose adds NaOH, the reaction occurs in the presence of an organic acid and an alkali metal hydroxide as claimed.

Applicants respectfully disagree.

Claim 1 recites "reacting a polyfunctional amine ingredient with a polyfunctional acid ingredient in the presence of at least an alkali metal hydroxide and an organic acid" (underlining added). In contrast, Hirose discloses that a layer is formed on a porous support by coating the support with a solution A (comprising one or more polyfunctional amines), then this layer is contacted with solution B (comprising one or more polyfunctional acid halide compounds) and further contacted with solution C (comprising polyfunctional acid halide compounds) to form a polyamide skin layer on the porous support. During this process, there is no alkali metal hydroxide or organic acid present. In addition, Hirose discloses that after contact with solution C (i.e., after the polyamide skin layer is formed), the layer is contacted with at least either an acidic aqueous solution or an alkaline aqueous solution.

Therefore, Hirose does not disclose reacting a polyfunctional amine ingredient with a polyfunctional acid ingredient in the presence of at least an alkali metal hydroxide and an organic acid, as recited in claim 1.

Regarding Tomaschke, the Examiner asserts that Tomaschke discloses a process of producing a polyamide membrane made by interfacial polymerization of a polyamine and a polyacid chloride in the presence of camphor sulfonic acid and sodium hydroxide on polysulfone porous membrane and directs Applicants' attention to Example 1.

In Example 1 in Tomaschke, a 4,4'-bipiperidine reactant, TEACSA and sodium lauryl sulfate are combined. TEACSA contains a salt of triethylamine and camphorsulfonic acid. The

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aqueous solution of 4,4'-bipiperidine reactant is coated on a substrate and the substrate is contacted with trimesoyl chloride. Since TEACSA is a salt of triethylamine and camphor sulfonic acid, it cannot be considered that the triethylamine part of TEACSA reacts with trimesoyl chloride.

Thus, Tomaschke does not disclose reacting a polyfunctional amine ingredient with a polyfunctional acid ingredient in the presence of at least an alkali metal hydroxide and an organic acid, as recited in claim 1.

In addition, bipiperidine is an essential component of Tomaschke's invention, whereas claim 1 recites that a polyfunctional amine ingredient is reacted with a polyfunctional acid ingredient in the presence of at least an alkali metal hydroxide and an organic acid, and that the polyfunctional amine ingredient is an aromatic or aliphatic polyfunctional amine ingredient.

Further, the Examiner asserts that Applicants' claimed normality ratio of organic acid to sodium hydroxide is inherently disclosed in Tomaschke since Tomaschke teaches the pH falls in the same range as claimed (see claim 7).

Applicants respectfully disagree.

In Example 1 in Tomaschke, the pH of the 4,4'-bipiperidine reactant is adjusted to 12.75. This is outside the pH range recited in claim 7. Additionally, in col. 8, lines 19-22, Tomaschke discloses that the aqueous solution containing a bipiperidine reactant generally has a pH of about 10 to about 14, preferably about 11 to about 13. Therefore, the normality ratio of organic acid to sodium hydroxide in Tomaschke is also outside the range recited in claim 6.

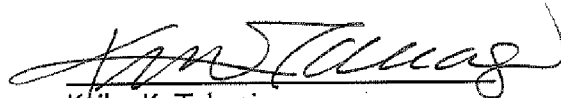
For the above reasons, it is respectfully submitted that Hirose and Tomaschke fail to anticipate claim 1, or the claims depending therefrom.

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In view of the above, Appellants respectfully request the Pre-Appeal Brief Conference Panel to withdraw the foregoing rejection.

Respectfully submitted,



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